IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	Atty. Docket
DARWIN HE, ET AL.	NL 020795
	Confirmation No. 1795
Serial No. 10/525,138	Group Art Unit: 2434
Filed: FEBRUARY 16, 2005	Examiner: SANDERS, STEPHAN

Title: COMMUNICATION SYSTEM AND METHOD BETWEEN A RECORDING AND/OR REPRODUCING DEVICE AND A REMOTE UNIT

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APPEAL BRIEF

Sir:

Appellants herewith respectfully present a Brief on Appeal as follows, having filed a Notice of Appeal on August 26, 2009:

REAL PARTY IN INTEREST

The real party in interest in this appeal is the assignee of record Koninklijke Philips Electronics N.V., a corporation of The Netherlands having an office and a place of business at Groenewoudseweg 1, Eindhoven, Netherlands 5621 BA.

RELATED APPEALS AND INTERFERENCES

Appellants and the undersigned attorney are not aware of any other appeals or interferences which will directly affect or be directly affected by or having a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-2, 4-6, 8-15, 18 and 20-24 are pending in this application, where claims 3, 7, 16-17 and 19 are canceled. Claims 1-2, 4-6, 8-15, 18 and 20-24 and are rejected in the Final Office Action mailed on May 26, 2009. This rejection was upheld in an Advisory Action mailed on August 7, 2009. Claims 1-2, 4-6, 8-15, 18 and 20-24 are the subject of this appeal.

STATUS OF AMENDMENTS

Appellants filed on July 27, 2009 an after final amendment in response to a Final Office Action mailed May 26, 2009. The after final amendment canceled claim 19 and included amendments to claims 1, 5-6, 8-9, 20 and 23-24. In an Advisory Action mailed on August 7, 2009, it is indicated that the after final amendment filed on July 27, 2009 will be entered, but does not place the application in condition for allowance. This Appeal Brief is in response to the Final Office Action mailed May 26, 2009, that finally rejected claims 1-2, 4-6, 8-15, 18 and 20-24, which remain finally rejected in the Advisory Action mailed on August 7, 2009.

SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention, for example, as recited in independent claim 1, shown in FIGs 1-2, and described on page 1, line 28 to page 2, line 17, and page 3, lines 3-32 of the specification, is directed to a communication method via a network 30 between a device 20 able to read a memory medium 22, and a remote unit 10 comprising additional data 11 for the memory medium 22. As described on page 4, line 33 to page 6, line 10 of the specification, the communication method comprises extracting memory medium properties 23 from the memory medium 22 inserted in the device 20, sending the memory medium properties 23 to the remote unit 10, authenticating the memory medium 22 by comparing the memory medium properties 23 with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data 11 to the device 20, and determining that the memory medium 22 is illegally produced when the memory medium properties 23 are different from the corresponding properties even if the memory medium 22 includes identical content

for rendering as the corresponding memory medium. As described on page 6, liens 1-7, the memory medium properties 23 include a region code of the memory medium 22.

The present invention, for example, as recited in independent claim 5, shown in FIGs 1-2, and described on page 1, line 28 to page 2, line 17, and page 3, lines 3-32 of the specification, is directed to a communication system comprising a device 20 able to read a memory medium 22, and a remote unit 10 comprising additional data 11 for the memory medium 22. As described on page 4, line 33 to page 6, line 10 of the specification, the device 20 and the remote unit 10 communicate via a network 30, where the remote unit 10 is able to retrieve memory medium properties 23 from the memory medium 22 inserted in the device 20, to authenticate the memory medium 22 by comparing the memory medium properties 23 with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data 11 to the device 20, and to determine that the memory medium 22 is

illegally produced when the memory medium properties 23 are different from the corresponding properties even if the memory medium 22 includes identical content for rendering as the corresponding memory medium. As described on page 6, liens 1-7, the memory medium properties 23 include a region code of the memory medium 22.

The present invention, for example, as recited in independent claim 6, shown in FIGs 1-2, and described on page 1, line 28 to page 2, line 17, and page 3, lines 3-32 of the specification, is directed to a remote unit 10 for communicating with a device 20 able to read a memory medium 22. As described on page 4, line 33 to page 6, line 10 of the specification, the remote unit 10 comprising additional data 11 for the memory medium 22, means such as a processor for retrieving memory medium properties 23 from the memory medium 22 inserted in the device 20, means such as the processor for authenticating the memory medium 23 by comparing the memory medium properties 23 with corresponding properties of a

corresponding memory medium legally produced by a provider, before sending the additional data 11 to the device 20, and means such as the processor for determining that the memory medium 23 is illegally produced when the memory medium properties 23 are different from the corresponding properties even if the memory medium 22 includes identical content for rendering as the corresponding memory medium. As described on page 6, liens 1-7, the memory medium properties 23 include a region code of the memory medium 22.

The present invention, for example, as recited in independent claim 8, shown in FIGs 1-2, and described on page 1, line 28 to page 2, line 17, and page 3, lines 3-32 of the specification, is directed to a computer readable medium embodying a computer program comprising program instructions for implementing, when the program is executed by a processor, a communication method via a network 30 between a device 20 able to read a memory medium 22, and a remote unit 10 comprising additional data 11 for the memory medium 22.

As described on page 4, line 33 to page 6, line 10 of the specification, the communication method comprises extracting memory medium properties 23 from the memory medium 22 inserted in the device 20, sending the memory medium properties 23 to the remote unit 10, and determining that the memory medium 22 is illegally produced when the memory medium properties 23 are different from corresponding properties of a corresponding memory medium legally produced by a provider even if the memory medium 22 includes identical content for rendering as the corresponding memory medium. As described on page 6, liens 1-7, the memory medium properties 23 include a region code of the memory medium 22.

The present invention, for example, as recited in independent claim 9, shown in FIGs 1-2, and described on page 1, line 28 to page 2, line 17, and page 3, lines 3-32 of the specification, is directed to a computer readable medium embodying a computer program comprising program instructions for implementing, when the program is executed by a processor, a communication method via a network 30

between a device 20 able to read a memory medium 22, and a remote unit 10 comprising additional data 11 for the memory medium 22. As described on page 4, line 33 to page 6, line 10 of the specification, the communication method comprises retrieving memory medium properties 23 from the memory medium 22 inserted in the device 20, authenticating the memory medium 22 by comparing the memory medium properties 23 with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data 11 to the device 20, and determining that the memory medium 22 is illegally produced when the memory medium properties 23 are different from the corresponding properties even if the memory medium 22 includes identical content for rendering as the corresponding memory medium. As described on page 6, liens 1-7, the memory medium properties 23 include a region code of the memory medium 22.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-2, 4-6, 8-15 and 20-24 of U.S. Patent Application Serial No. 10/525,138 are unpatentable under 35 U.S.C. §102(b) over WO 01/90860 (Schwartz).

Whether claim 18 of U.S. Patent Application Serial No. 10/525,138 is unpatentable under 35 U.S.C. §103(a) over Schwartz in view of U.S. Patent Application Publication No. 2003/0110192 (Valente).

ARGUMENT

Claims 1-2, 4-6, 8-15 and 20-24 are said to be unpatentable under 35 U.S.C. §102(b) over Schwartz.

Appellants respectfully request the Board to address the patentability of independent claims 1, 5-6 and 8-9, and further claims 2, 4, 10-15, 18 and 20-24 as depending from claims 1, 5-6 and 8-9, based on the requirements of independent claims 1, 5-6 and 8-9. This position is provided for the specific and stated purpose of simplifying the current issues on appeal. However, Appellants herein specifically reserve the right to argue and address the patentability of claims 2, 4, 10-15, 18 and 20-24 at a later date should the separately patentable subject matter of claims 2, 4, 10-15, 18 and 20-24 later become an issue. Accordingly, this limitation of the subject matter presented for appeal herein, specifically limited to discussions of the patentability of claims 1, 5-6 and 8-9 is not intended as a waiver of Appellants' right to argue the patentability of the further claims and claim elements at that later time.

Schwartz is directed to a method for authenticating that a specified pre-recorded media (e.g., CD) is inserted into a drive

for granting access to restricted content related to a specific prerecorded media. On page 10 of the Final Office Action, in rejecting claim 19, it is alleged that certain portions of Schwartz, namely, the Abstract page 1, 19-25; page 2, lines 18-21; and the claims of Schwartz, disclose that "the memory medium properties includes a region code of the memory medium," as recited in independent claims 1, 5-6 and 8-9.

Applicants respectfully disagree and submit that Schwartz does not disclose or suggest that "the memory medium properties include a region code of the memory medium." Rather, the portions of Schwartz noted on page 10 of the Final Office Action, merely describe allowing download of additional data, i.e., restricted content or bonus track, if information "descriptive of the data on the prerecorded media ... fits a predetermined criteria, as described in the Abstract and page 1, lines 1-8 and 19-25; page 2, lines 18-21.

Further, the claims of Schwartz do not disclose or suggest anything related to region codes. Rather claim 4 of Schwartz, for example, merely recites "generating a unique identifier for the CD

ROM, the unique identifier being a function of two or more of a number of tracks on the CD, a length of each track, an order of each track, and a total track length of the CD."

It is respectfully submitted that Schwartz does not disclose or suggest the present invention as recited in independent claim 1, and similarly recited in independent claims 5-6 and 8-9 which, amongst other patentable elements, recites (illustrative emphasis provided):

> authenticating the memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to the device, ...
>
> wherein the memory medium properties include a **region code** of the memory medium.

Authenticating a memory medium by using memory medium properties that include a region code of the memory medium is nowhere disclosed or suggested in Schwartz. This provides substantial benefits, such as providing different types of enhanced content and advertisements that depend on the region code of the disc.

Schwartz recites on page 14, first full paragraph, that "other

types of corresponding data other than multimedia (e. g., program codes, encrypted data, etc.) may also be utilized in accordance with a preferred embodiment of the present invention." However, Schwartz does not disclose or suggest any region codes, let alone disclosing or suggesting to authenticate the memory medium using a region code of the memory medium.

In the Advisory Action of August 7, 2009, it is alleged that region codes "are standard data within memory medium properties and contrary to Applicant's argument, are disclosed in prior art Schwartz (Schwartz: Abstract; Field of Invention page 1, lines 1-8; Summary of Inventions and page 1, lines 19-25; page 2, lines 18-21; See claims)" It is respectfully submitted that a careful review of the noted portions of Schwartz reveals no disclosure or suggestion of any region codes.

Further even assuming, arguendo, that region codes "are standard data within memory medium properties," as alleged in the Advisory Action, there is still no disclosure or suggestion in Schwartz to determine that the memory medium is illegally produced based on medium properties that include the region code, as recited

in independent claims 1, 5-6 and 8-9. Valente is cited to allegedly show other features and does not remedy the deficiencies in Schwartz.

Accordingly, it is respectfully requested that independent claims 1, 5-6 and 8-9 be allowed. In addition, it is respectfully submitted that claims 2, 4, 10-15 and 20-24 should also be allowed at least based on their dependence from independent claims 1 and 5-6 as well as their individually patentable elements.

Claim 18 is said to be unpatentable under 35 U.S.C. §103(a) over Schwartz in view of Valente.

It is respectfully submitted that claim 18 should be allowed at least based on its dependence indirectly from independent claim 1.

In addition, Appellants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the

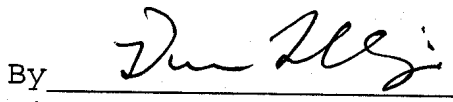
presented remarks. However, Appellants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

CONCLUSION

Claims 1-2, 4-6, 8-15, 18 and 20-24 are patentable over Schwartz and Valente.

Thus, the Examiner's rejections of claims 11-2, 4-6, 8-15, 18 and 20-24 should be reversed.

Respectfully submitted,

By 
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CLAIMS APPENDIX

1. (Previously Presented) A communication method via a network between a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said communication method comprising the acts of:

extracting memory medium properties from the memory medium inserted in the device,

sending said memory medium properties to the remote unit,

authenticating the memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to the device, and

determining that the memory medium is illegally produced when the memory medium properties are different from the corresponding properties even if the memory medium includes identical content for rendering as the corresponding memory medium, wherein the memory medium properties include a region code of the memory medium.

2.(Previously Presented) The communication method as claimed in claim 1, wherein the memory medium properties are written in a control data zone of the memory medium.

Claim 3 (Canceled)

4.(Previously Presented) The communication method as claimed in claim 1, wherein the remote unit is able to send different types of additional data as a function of the memory medium properties.

5.(Previously Presented) A communication system comprising a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said device and the remote unit communicating via a network, wherein the remote unit is able to retrieve memory medium properties from the memory medium inserted in the device, to authenticate said memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to said device, and to

determine that the memory medium is illegally produced when the memory medium properties are different from the corresponding properties even if the memory medium includes identical content for rendering as the corresponding memory medium, wherein the memory medium properties include a region code of the memory medium.

6. (Previously Presented) A remote unit for communicating with a device able to read a memory medium, the remote unit comprising additional data for the memory medium, means for retrieving memory medium properties from the memory medium inserted in the device, means for authenticating said memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to said device, and means for determining that the memory medium is illegally produced when the memory medium properties are different from the corresponding properties even if the memory medium includes identical content for rendering as the corresponding memory medium, wherein the memory medium properties include a region code of the memory medium.

Claim 7 (Canceled)

8.(Previously Presented) A computer readable medium embodying a computer program comprising program instructions for implementing, when said program is executed by a processor, a communication method via a network between a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said communication method comprising the acts of:

extracting memory medium properties from the memory medium inserted in the device,

sending said memory medium properties to the remote unit, and determining that the memory medium is illegally produced when the memory medium properties are different from corresponding properties of a corresponding memory medium legally produced by a provider even if the memory medium includes identical content for rendering as the corresponding memory medium, wherein the memory medium properties include a region code of the memory medium.

9.(Previously Presented) A computer readable medium embodying a computer program comprising program instructions for implementing, when said program is executed by a processor, a communication method via a network between a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said communication method comprising the acts of:

retrieving memory medium properties from the memory medium inserted in the device,

authenticating the memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to the device, and determining that the memory medium is illegally produced when the memory medium properties are different from the corresponding properties even if the memory medium includes identical content for rendering as the corresponding memory medium, wherein the memory medium properties include a region code of the memory medium.

10.(Previously Presented) The communication method of claim

1, wherein the memory medium comprises at least one read-only, recordable, and rewritable discs.

11.(Previously Presented) The communication method of claim 1, wherein the memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs.

12.(Previously Presented) The communication system of claim 5, wherein the memory medium comprises at least one read-only, recordable, and rewritable discs.

13.(Previously Presented) The communication system of claim 5, wherein the memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs.

14.(Previously Presented) The remote unit of claim 6, wherein the memory medium comprises at least one read-only, recordable, and rewritable discs.

15.(Previously Presented) The remote unit of claim 6, wherein the memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs.

Claims 16-17 (Canceled)

18.(Previously Presented) The communication method of claim 1, further comprising the act of blacklisting the device if the remote unit receives a number of requests higher than a predetermined threshold from the device containing a non-authenticated memory medium.

Claim 19 (Canceled)

20.(Previously Presented) The communication method of claim 1, wherein the additional data includes advertisement depending on the region code.

21.(Previously Presented) The communication method of claim

1, further comprising the act of allowing recording of the additional data if the authenticating act is successful.

22. (Previously Presented) The communication method of claim 1, further comprising the act of allowing access to the additional data only while the memory medium is being played in the device.

23. (Previously Presented) The communication system of claim 5, wherein the additional data includes advertisement depending on the region code.

24. (Previously Presented) The remote unit of claim 6, wherein the additional data includes advertisement depending on the region code.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None